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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,958	12/10/2003	Takashi Igarashi	KON-1843	6771

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EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

10/731,958

Applicant(s)

IGARASHI ET AL.

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Application No. 10/731958 filed on 12/10/2003 has been examined. In this Office Action, claims 1-7 are pending.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The examiner has considered the certified copy of the Application Japan 2002-363564 dated 12/16/2002 for priority claiming.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: In the claim 1, on line 20 claiming as "predefined condition" where as in the specification on page 31, line 13 stated as "predefined rule" not given specific rule other an a broad example given in

the parenthesis. The page 31 itself is a continuation sheet of the example 3 implementation. Therefore, there is no specific rule clearly defined and it is a burden for the examiner to interpret the predefined rule. Further clarification is needed or amend the claim to overcome this problem.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-7 are rejected under 35 U.S.C. § 101, because claims are directed to program per se. Independent claim 1 is claiming a computer program per se and functional descriptive material consisting of data structures and computer programs, which impart functionality when employed as a computer component. As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Yaegashi et al. (US Patent 6,577,807) hereinafter Yaegashi.

9. As per independent claim 1, Yaegashi teaches a method producing a tree structure of images for a program even if the moving pictures to be edited are not stored in an information storage unit (col. 1, lines 63-67). Yaegashi teaches the claimed, a reading section to read a data set recorded in a recording medium as an additional data set to be added in the recording section (Fig. 2, col. 5, lines 19-23). Yaegashi teaches the claimed, a data control structure analyzing section to analyze the data control structure of the additional data set read by the reading section and to compare the analyzed data control structure of the additional data set with the data control structure of a data set stored in a hierarchical position in the hierarchical structure at where the additional data set is linked (Fig. 9-11, 13A, col. 12, lines 4-24). Yaegashi teaches the claimed, a data control structure generating section to rewrite the hierarchical structure, wherein when the comparison result of the data control structure analyzing section satisfies a predetermined condition, the data control structure generating section adds

the additional data set in the recording section by linking the additional data at the hierarchical position in the hierarchical structure (Fig. 2, col. 5, lines 1-43).

10. As per dependent claim 3-4, Yaegashi teaches the claimed, the data control structure generating section links the additional data set at the hierarchical position lower than the stored data set in the hierarchical structure (Fig. 11, col. 5, line 57 to col. 6, line 9).

11. As per dependent claim 5, Yaegashi teaches the claimed, in the case that the data control structure of the stored data set includes a first folder of a first name and a second folder of a second name located lower than the first folder in the hierarchical structure, when the comparison results indicates that the data control structure of the additional data set also includes the first folder of the first name and the second folder of the second name, the data control structure generating section judges that the comparison results the predetermined condition and the data control structure generating section adds the additional data set in the recording section (Fig. 9, col. 11, lines 51-67).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaegashi et al. (US Patent 6,577,807) hereinafter Yaegashi, and in view of Ohmura et al. (USPA Pub. 2002/0145633 A1) hereinafter Ohmura.

14. As per dependent claim 2, Yaegashi does not teach dealing with folders. However, Ohmura teaches the claimed, in the case that the data control structure of the stored data set includes a first folder and a second folder located lower than the first folder in the hierarchical structure, when the comparison results indicates that the data control structure of the additional data set also includes the first folder and the second folder, the data control structure generating section judges that the comparison result satisfies the predetermined condition and the data control structure generating section adds the additional data set in the recording section (Fig. 28, page 11, paragraph

[0153]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).

15. As per dependent claim 6, Ohmura teaches the claimed, the reading section reads a data set recorded in the recording medium as the additional data, the reading section renames the name of a folder of the additional data set (Fig. 23, page 11, paragraph [0148]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).


16. As per dependent claim 7, Ohmura teaches the claimed, the first folder indicates a storing position of the image data and the second folder indicates a data storing directory (Fig. 16-21, page 11, paragraph [0157]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Ohmura's teachings would have allowed Yaegashi's method to provide a visualization of the thumbnail images in order to print only selected images instead of all images (col. 2, lines 22-25).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sathyanarayan Pannala
Examiner
Art Unit 2164

srp
May 29, 2006